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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,315	02/09/2006	Ban Chin To	105SR-019	6117
32192 BRADLEY N. RUBEN, PC 463 FIRST ST, SUITE 5A HOBOKEN, NJ 07030	7590 03/27/2008		EXAMINER MAKIYA, DAVID J	
			ART UNIT 2885	PAPER NUMBER
			MAIL DATE 03/27/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/501,315

**Applicant(s)**

TO, BAN CHIN

**Examiner**

David J. Makiya

**Art Unit**

2885

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-58 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 34-58 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 31 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 1/26/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 1/3/2008 has been entered.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-36, 41-42, 49-52, and 56-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Caluori (US Patent 5,609,414).

With respect to claim 34, Caluori teaches a light fitting having a support surround 14 and a front fascia 24, and a fascia retainer 26 for holding the front fascia in position in the support surround (Column 3, Lines 19-21), the fascia retainer being resilient for enabling removal of the fascia from an installed position thereof by a generally translational movement (Column 1, Lines 15-20), the light fitting further having a lamp retainer and a lamp 2 wherein the lamp is retained by the lamp retainer, the lamp being resiliently biased toward the front fascia such that the lamp may be moved backwards away from a recessed ledge of the fascia to enable a finger or a tool to be engaged behind the ledge to facilitate removal of the front fascia from the support surround (Column 3, Lines 11-21 and Column 5, Lines 13-15).

With respect to claim 35, Caluori teaches the light fitting in which the lamp retainer forms the front fascia (Column 3, Lines 19-21).

With respect to claim 36, Caluori teaches the light fitting in which the lamp retainer comprises a tube extending axially in front of the lamp (Figure 1).

With respect to claim 41, Caluori teaches the light fitting in which the support surround includes at least one spring arm 40 for holding the light fitting in place on a layer of building material 3.

With respect to claim 42, Caluori teaches the light fitting in which the front facia is directly retained by the facia retainer to the support surround (Column 3, Lines 19-21).

With respect to claim 49, Caluori teaches the light fitting in which the facia retainer comprises at least one spring clip (26, 40).

With respect to claim 50, Caluori teaches the light fitting in which a pair of said spring clips 40 is provided, located on opposed sides of the light fitting (Figure 1).

With respect to claim 51, Caluori teaches the light fitting in which each spring clip 26 is secured to the front facia (Figure 1).

With respect to claim 52, Caluori teaches the light fitting with resilient biasing for biasing the lamp towards the front facia is provided by a spring (Column 3, Lines 19-21).

With respect to claim 56, Caluori teaches the light fitting in which the facia includes a recessed ledge for engaging the perimeter of a lamp (Figure 1).

With respect to claim 57, Caluori teaches the light fitting which includes a lamp 92, the lamp having a flat front surface (Figure 1).

With respect to claim 58, Caluori teaches the light fitting which comprises a downlighter (Figure 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori in view of Jones (US 2002/0080602).

With respect to claims 37-40, Caluori teaches the light fitting as described above.

However, Caluori fails to teach a particular shape for the front facia to have a non-circular cross section.

Jones teaches a light fitting having a support surround 32 and a front facia 60 and a tube 56 extending axially in front of the lamp wherein the front facia has a non-circular cross-section, including square, regular polygon, or hexagonal (Paragraph 56).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the cross sectional shape of the front facia of Caluori with the non-circular shape from the teaching of Jones, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Caluori.

Claims 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori in view of Connors et al. (US Patent 5,836,677).

With respect to claims 43-48, Caluori teaches the light fitting as described above.

However, Caluori fails to teach the front facia attached by the facia retainer to an intermediate member nor does it teach a particular shape for the intermediate member.

Connors et al. teaches a light fitting comprising a support surround 12, and a front facia 28, and a facia retainer 26 wherein the front facia is attached by the facia retainer to an intermediate member 18, the intermediate member being pivotably connected to the support surround (Figure 3) and the intermediate has a non-circular cross-section, including square, regular polygon, or hexagonal (Column 4, Lines 1-5).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting of Caluori by adding the intermediate member from the teachings of Connors et al. would “minimize light loss ... [because] light is not allowed to leak behind the reflective disk and become ‘wasted’ within the reflector 10 or light fixture 12” (Connors et al.; Column 3, Lines 30-48).

Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori in view of Houplain (European Patent 233,465).

With respect to claims 53-55, Caluori teaches the light fitting with resilient biasing for biasing the lamp towards the front facia as described above.

However, Caluori fails to teach the resilient biasing for biasing the lamp towards the front facia is provided by a helical spring.

Houplain teaches a light fitting comprising a support surround 1 and a front facia 6 and a facia retainer 15, the facia retainer being resilient, in which the resilient biasing for biasing the lamp towards the front facia is provided by two helical springs (Figure 5) each extending from an end of a lamp 11 opposite a lens end thereof to a lamp retainer 13 and from an electrical connector to the lamp retainer (Column 4, Lines 60-65).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the resilient biasing of Caluori with the helical springs from the teachings of Houplain because "the light fitting (11) and the socket (12) are held together with springs (15)" (Houplain; Column 4, Lines 60-65) to ensure the electrical connection.

### ***Response to Arguments***

Applicant's arguments with respect to claims 34-58 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Janos et al. (US Patent 5,944,412) and Yang (US Patent 7,255,461; same Assignee) teach light fittings with a support surround, a front facia, and a facia retainer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Makiya whose telephone number is (571) 272-2273. The examiner can normally be reached on Monday-Friday 7:30am - 4:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



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/DJM/ 03/20/2008

/Jong-Suk (James) Lee/  
Supervisory Patent Examiner, Art Unit 2885